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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/719,162	11/21/2003	Jacob Lahijani	FL0233USNA	2357

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EXAMINER	
FLETCHER III, WILLIAM P	
ART UNIT	**PAPER NUMBER**
1792	

NOTIFICATION DATE	DELIVERY MODE
09/22/2009	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

PTO-Legal.PRC@usa.dupont.com

Office Action Summary	Application No.	Applicant(s)	
	10/719,162	LAHIJANI, JACOB	
	Examiner	Art Unit	
	William P. Fletcher III	1792	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *21 July 2009*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1,4-7,14-16 and 18* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1,4-7,14-16 and 18* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on July 21, 2009, has been entered.

Response to Amendment

2. Claims 1, 4-7, 14-16, and 18, remain pending.

Response to Arguments

3. Applicant's arguments, see the remarks, filed July 21, 2009, with respect to the rejection(s) of claim(s) 1, 4-8, and 14-18, under 35 USC 103(a), have been fully considered and are persuasive. Specifically, as noted by Applicant, Wu teaches a smooth, bubble-free surface in the absence of any metal particles [10:56 and 11:26]. One of ordinary skill in the art would not have been motivated to add the metal particles of JP '593 to suppress bubbling in a method already disclosed as yielding a bubble-free coating, since there is no evidence of a further advantage arising from the synergy of the two, different bubble-suppression means. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of the art cited below.

Claim Rejections - 35 USC § 103

4. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

5. Claims 1, 4-7, 14-16, and 18, are rejected under 35 U.S.C. 103(a) as being unpatentable over Tomihashi et al. (WO 00/58414 A1; reference made to US 6,734,236 B1 as English-language equivalent) in view of Buckmaster et al. (EP 0 226 668 B1).

A. Claim 1

i. Tomihashi teaches a dry, melt-flowable composition [1:65-2:16] comprising particles of tetrafluoroethylene/perfluoro(ethyl vinyl either) (TFE/PEVE) [2:20-45], having a particle size of 10-500 μm, preferably 20-300 μm [5:34-37], and additionally including 0.1-3.0 wt.-%, preferably 0.5-3.0 wt.-%, of a metal powder [4:62-67 and 5:5-10]. Disclosed examples of the metal powder include Zn, Sn, and/or Cu [4:62-67]; since these are the materials specifically disclosed and claimed by Applicant, it is the Examiner's position that they necessarily satisfy the claim limitations *adhesion promoting* and *non-bubble promoting*. The burden is on Applicant to clearly and convincingly demonstrate and/or explain how the disclosed Zn, Sn, and/or Cu powder of Tomihashi does not/cannot meet the limitations *adhesion promoting* and *non-bubble forming*.

ii. It is the Examiner's position that *rotolining* is merely a statement of the intended use: while the claims require that the composition be capable of rotolining, the claims do not actively recite utilizing the composition in a

rotolining process. The preamble is not a limitation on the claims if it merely states the purpose or intended use, and the remainder of the claim completely defines the invention independent of the preamble.[1] In other words, it is the Examiner's position that this limitation, appearing in the preamble, does not carry patentable any patentable weight because: (1) this limitation is not essential to understand limitations or terms in the claim body; (2) the preamble has not yet been relied upon during prosecution to distinguish the invention over this, newly-cited prior art; and (3) the claim body describes a structurally complete invention such that deletion of the preamble phrase does not effect the claimed compositional limitations of the claimed invention.[2] The claimed *adhesion to steel characterized by a peel strength of at least 25 lb/in* is not associated with any particular method of application in the claim. Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). Tomihashi expressly states that the composition may be applied by 'a method of lining by rotation molding' [5:40]. It is unclear from this ambivalent disclosure whether Tomihashi is disclosing roto*lining*, roto*molding*, or both. Since Tomihashi expressly teaches adherence to steel substrates [5:55-56], this reference clearly envisions the composition's being applied to a substrate and not being

[1] *Stewart-Warner Corp. v. City of Pontiac, Mich.*, 219 USPQ 1162; *Martson v. J.C. Penny Co., Inc.*, 148

removed therefrom (i.e., the reference includes coating/lining and is not limited to molding). Consequently, it is the Examiner's position that the composition of Tomihashi is capable of being used in a rotolining process, thereby satisfying the *rotolining* limitation of this claim as explained above. The burden is on Applicant to clearly and convincingly demonstrate and/or explain: (1) why the limitation *rotolining* must be given patentable weight beyond that detailed above; and (2) why the composition of Tomihashi is not capable of use in a rotolining process.

iii. Tomihashi teaches that the metal powder particles serve to stabilize the composition [4:62-67], thereby meeting the claimed *stabilized* TFE/PEVE copolymer. At this advanced point in prosecution, the Examiner acknowledges the specific type of stabilization disclosed at 5:31 ff. of the instant specification. This disclosure does not amount to an express definition of the term *stabilized* which the Examiner is obliged to apply to the interpretation of the claim. Further, there is nothing in the language of the claim correlating the term *stabilized* to any facet of this disclosed stabilization. Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). If Applicant were to specifically claim this form of stabilization, the Examiner would cite Buckmaster as teaching such stabilization of as a

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USPQ 25; *Kropa v. Robie and Mahlman*, 88 USPQ 478.

means of reducing bubbling [4:39 ff.], thereby rendering such stabilization obvious.

iv. While Tomihashi does not expressly teach that the TFE/PEVE copolymer has *a sphere factor of less than 1.5*, this reference places no limitation on what this parameter may be. Buckmaster, as disclosed and characterized by Applicant, teaches a dry, melt-flowable composition of TFE/PEVE suitable for coating application similar to those disclosed by Tomihashi, in which the TFE/PEVE particles have an average particle size of 200-3000 micrometers and a sphere factor of less than 1.5 [3:10-15, for example]. Since Tomihashi does not expressly limit the sphere factor, one of ordinary skill would have looked to the prior art to find useable particles of TFE/PEVE and it would have been obvious to one skilled in the art to modify the composition of Tomihashi so as to utilize, as the TFE/PEVE particles, particles having the sphere factor taught by Buckmaster. One skilled in the art would have been motivated to do so by the desire and expectation of successfully providing a dry, melt-flowable composition of TFE/PEVE.

v. Finally, the Examiner acknowledges that none of the cited references discloses an *adhesion to steel characterized by a peel strength of at least 25 lb/in*. It remains the Examiner's position that peel strength is a physical property of the claimed composition, and that because the prior

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[2] *Catalina Marketing International, Inc. v. Coolsavings.com, Inc.*, 62 USPQ2d 1781 (CAFC 2002).

art teaches all of the claimed compositional limitations, the composition of the cited prior art necessarily possesses the claimed peel strength. In other words, if the claimed composition and that of the cited prior art do not have the same, claimed peel strength, the difference must arise from some compositional and/or procedural limitation not claimed. The Examiner further notes that the claim does not correlate the peel strength to any compositional limitation (i.e., metal powder or stabilization) or procedural limitation (i.e., rotolining). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

B. Claims 4-6

i. As noted above, Tomihashi teaches that the metal powder is Zn, Sn, and/or Cu [4:62-67].

C. Claim 7

i. Tomihashi teaches that the composition is a physical mixture of copolymer and metal powder [Example 1], and there is no disclosure of heating above the melting point of the metals, which suggests that the metal powder remains distinct from the polymer thereby satisfying the limitation *wherein said metal powder is dispersed in said copolymer*.

D. Claims 14-16

i. As noted above, Tomihashi teaches 0.1-3.0 wt.-%, preferably 0.5-3.0 wt.-%, of Zn, Sn, and/or Cu, metal powder [4:62-67 and 5:5-10], thereby anticipating these claims.

E. Claim 18

i. It remains the Examiner's position that adhesion (or lack thereof) to steel is a physical property of the claimed composition, and that because the prior art teaches all of the claimed compositional limitations, the composition of the cited prior art necessarily possesses the claimed adhesion to steel. In other words, if the claimed composition and that of the cited prior art do not have the same, claimed adhesion properties, the difference must arise from some compositional and/or procedural limitation not claimed. The Examiner further notes that the claim does not correlate the adhesion to any compositional limitation (i.e., metal powder or stabilization) or procedural limitation (i.e., rotolining). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to William P. Fletcher III whose telephone number is (571)

272-1419. The examiner can normally be reached on Sunday, 5:00 AM - 12:00 PM and Monday through Friday, 5:00 AM - 3:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Timothy H. Meeks can be reached on (571) 272-1423. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/William Phillip Fletcher III/
Primary Examiner, Art Unit 1792

September 17, 2009